

REMARKS

In the Office Action mailed April 9, 2003, claims 9-12 under 35 USC 102(e) were rejected as being anticipated by Sato et al. (U.S. Patent No. 6,014,680), and claims 1-8 and 13-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al. in view of Wanderski et al. (U.S. Patent No. 6,519,617).

The foregoing rejections are respectfully traversed. Claims 1-14 are pending and under consideration.

REJECTION OF CLAIMS 9-12 UNDER 35 U.S.C. § 102(e) AS BEING ANTICIPATED BY SATO ET AL. (U.S. PATENT NO. 6,014,680)

Claims 9-12 are rejected under 35 U.S.C. §102(e) as being anticipated by Sato et al. ("Sato"). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Sato discloses a structured document generating method and apparatus using a keyword extraction module to extract a keyword representative of the document structure from a non-structured document by using a keyword extracting rule, and a keyword/text model is generated which is described by two elements including keywords and other strings.

In contrast to Sato, independent claim 9 of the present invention recites: "A computer-readable recording medium on which a structured document created in accordance with a predetermined document type definition is recorded, said medium comprising: ... *a plurality of element declarations which respectively define a plurality of types of logical structures for said one document instance* ..."

In the present invention, the structured document includes a document type definition ("DTD") that defines a document structure of the structured document, including a plurality of element declarations which respectively define a plurality of logical structures for the one document instance. In the present invention, the one structured document includes a plurality of types of logical structures using a single DTD. Therefore, one document instance, which has been defined in terms of one DTD, can be used in multiple applications, i.e., printing, saving in a database, etc.

In particular contrast to the present invention, Sato does not discuss or support a computer-readable recording medium comprising a structured document containing a single

DTD that defines a plurality of logical structures to be used with the structured document. Instead, Sato discloses a structured document containing multiple DTDs to define a plurality of logical structures to be used with structured documents.

The present invention claims a document instance having a plurality of types of logical structures using a DTD corresponding to the plurality of logical structures to create a structured document.

The recitations of claims 9-12 in the present application patentably distinguish over Sato in that Sato discloses a structured document apparatus comprising an SGML document for each logical structure of the hierarchical structure form layout, even when the SGML documents are identical in content, because each of the logical structures has an associated SGMI having a corresponding DTD.

Therefore, for at least this reason, independent claim 9 is distinguishable over the cited prior art.

Each of claims 10-12 depends from claim 9. Therefore, for at least the reasons that claim 9 patentably distinguishes over the reference relied upon, it is respectfully submitted that each of claim 10-12 also distinguishes over the reference relied upon.

REJECTION OF CLAIMS 1-8 AND 13-14 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER SATO IN VIEW OF WANDERSKI ET AL. (U.S. PATENT NO. 6,519,617)

Claims 1-8 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato in view of Wanderski et al. ("Wanderski").

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Wanderski relates to a method, system, and computer-readable code for translating an input document into an XML dialect, which is well formed, such that automated, dynamically selected transformations can be applied to the document.

The combination of Sato and Wanderski results in a structured document generating

method and apparatus that incorporates SGML and XML languages to create structured document and a keyword extraction module to extract a keyword representative of the document structure from a non-structured document by using a keyword extracting rule, and a keyword/text model is generated which is described by two elements including keywords and other strings.

In contrast to the present invention, the combination of Sato and Wanderski neither discusses nor supports the claim limitations of the present invention. In particular, neither reference, alone or in combination, discusses or suggests the claimed element recited in independent claim 1: "... *a plurality of element declarations which respectively define a plurality of types of logical structures for said one document instance ...*."

Sato merely discloses extracting one or more keywords from a non-structural document and then relating each of the extracted keywords to a predetermined DTD. In contrast, the present invention can be realized without the Sato keyword extracting method. Furthermore, in the present invention, one DTD includes a plurality of types of logical structures, each of which is defined according to the purpose of the document instance.

As previously discussed, the claims in the present invention patentably distinguish over the combination of Sato and Wanderski in that the Sato and Wanderski combination discloses a structured document apparatus comprising an SGML or XML document for each logical structure of the hierarchical structure form layout, even when the SGML documents are identical in content, because each of the logical structures has an associated SGMI having a corresponding DTD.

In contrast, the present invention claims a structured document having a plurality of types of logical structures using a DTD corresponding to the plurality of logical structures to create a structured document.

Therefore, it would *not* have been obvious to a person of ordinary skill in the art at the time present the invention was made to combine the Sato and Wanderski references to create a method for creating a structured document such that one document instance has a plurality of types of logical structures using a DTD, wherein the one structured document, defined in terms of one DTD, can be used for multiple purposes, such as printing and saving.

The foregoing references relied upon teach away from the present invention in that they disclose a method of using DTDs that requires preparing an SGML or XML document for each logical structure of the hierarchical structure form layout, even though the SGML documents may

be identical in content.

The present invention is an improved and more efficient method for creating structured documents than the method discussed and suggested by Sato and Wanderski.

Further, there is no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of the present invention to make the invention in the manner claimed. The reference must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

Similarly, each of independent claims 13 and 14 of the present invention recites: (again using the recitation of claim 1 as an example) “... *a plurality of element declarations which respectively define a plurality of types of logical structures for said one document instance* ...” Therefore, for at least the reasons that claim 1 is distinguished over the cited prior art, it is respectfully submitted that each of claim 13 and 14 also distinguishes over the cited prior art.

Moreover, each of dependent claims 2-8 are patentably distinct from the references relied upon and depend respectively from independent claim 1. Therefore, for at least the reasons that claim 1 is distinguished over the references relied upon, it is respectfully submitted that each of claim 2-8 also distinguishes over the references relied upon.

Withdrawal of the foregoing rejections is respectfully requested.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited, and, otherwise, an interview with the Examiner is respectfully requested.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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By:



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